

12-28-01

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Attorney Docket **P1712R1-1D1**  
PATENT

EV 016056206 US: Express Mail Number

December 19, 2001: Date of Deposit

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOX PATENT APPLICATION  
Assistant Commissioner of Patents  
Washington, D.C. 20231

**NON-PROVISIONAL APPLICATION TRANSMITTAL UNDER 37 CFR 1.53(b)**

Transmitted herewith for filing is a non-provisional patent application:

Inventor(s) (or Application "Identifier"):

Yves Dubaquie, San Francisco, California  
Paul J. Fielder, Redwood City, California  
Henry B. Lowman, El Granada, California  
Deborah L. Mortensen, Pacifica, California

Title: **PROTEIN VARIANTS**

**1. Type of Application**

- ☐ This application is for an original, non-provisional application.
- ☐ This is a non-provisional application claiming priority to provisional application no. \_\_, filed \_\_, the entire disclosure of which is hereby incorporated by reference.
- ☒ This is a ☐ continuation-in-part ☐ continuation ☒ divisional application claiming priority to application Serial Number 09/477,924, filed January 5, 2000, which is a non-provisional application filed under 37 CFR 1.53(b)(1), claiming priority under 35 USC §119 to provisional application no. 60/170,261 filed December 9, 1999 and provisional application No. 60/115,010 filed January 6, 1999, the entire disclosures of which are hereby incorporated by reference.

**2. Papers Enclosed Which Are Required For Filing Date Under 37 CFR 1.53(b) (Non-provisional )**

43 pages of specification  
2 pages of claims  
1 page(s) of abstract  
12 sheet(s) of drawings  
☒ formal ☐ informal

12/19/01  
JC860 U.S. PTO

JC860 U.S. PTO  
10/028410  
12/19/01

10023410-121504

### 3. Declaration or Oath

\_\_\_\_ (for new and CIP applications; also for Cont./Div. where inventor(s) are being added)  
An executed declaration of the inventor(s) ☐ is enclosed ☐ will follow.

X (for Cont./Div. where inventorship is the same or inventor(s) being deleted)  
A copy of the executed declaration/oath filed in the prior application is enclosed (37 CFR 1.63(d)).

— A signed statement is attached deleting inventor(s) named in the prior application (see 37 CFR 1.63(d)(2) and 1.33(b)).

#### 4. Assignment

— *(for new and CIP applications)*  
An Assignment of the invention to GENENTECH, INC. is enclosed with attached Recordation Form Cover Sheet will follow.

(for cont./div.)  
X The prior application is assigned of record to Genentech, Inc.

**5. Amendments (for continuation and divisional applications)**

\_\_\_\_\_ Cancel in this application original claims \_\_ of the prior application before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)

\_\_\_\_\_ A preliminary amendment is enclosed. (Claims added by this amendment have been properly numbered consecutively beginning with the number next following the highest numbered original claim in the prior application.)

The fee has been calculated as follows:

[illegible]

The Commissioner is hereby authorized to charge Deposit Account No. 07-0630 in the amount of \$740. **A duplicate copy of this transmittal is enclosed.**

The Commissioner is hereby authorized to charge any additional fees required under 37 CFR §1.16 and 1.17, or credit overpayment to Deposit Account No. 07-0630. **A duplicate copy of this sheet is enclosed.**

☐ Information Disclosure Statement (37 CFR §1.98) w/ PTO-1449 and citations

☐ Submission of "Sequence Listing", computer readable copy, certificate re: sequence listing, and/or amendment pertaining thereto for biological invention containing nucleotide and/or amino acid sequence.

☐ A new Power of Attorney or authorization of agent.

☒ Other: Communication Regarding Grouping of Inventions

*[This item **must** be completed and the necessary papers filed in the prior application if the period set in the prior application has run]*

\_\_\_\_\_ A petition, fee and/or response has been filed to extend the term in the pending prior application until \_\_\_\_\_

\_\_\_\_\_ A copy of the petition for extension of time in the **prior** application is attached.

11. **Correspondence Address:**

X Address all future communications to:

Attn: Janet E. Hasak

Respectfully submitted,  
GENENTECH, INC.

Date: December 17, 2001

By: Janet E. Hasak  
Janet E. Hasak  
Reg. No. 28,616  
Telephone No. (650) 225-1896

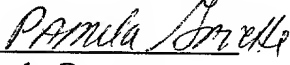


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PATENT TRADEMARK OFFICE

1002340-421904

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Yves Dubaquitte et al. Serial No.: Unassigned Filed: <u>19</u> December 2001 For: PROTEIN VARIANTS	Group Art Unit: Unassigned Examiner: Unassigned  <b>CERTIFICATION UNDER 37 CFR 1.10</b> <u>EV 016056206 US</u> : Express Mail Number <u>December 19, 2001</u> : Date of Deposit  I hereby certify that this correspondence, consisting of Non-Provisional Application Transmittal Under 37 CFR 1.53(b), specification, formal drawings, Letter and Request to Use Computer-Readable Sequence Listing Under 37 CFR §1.821(e), postcard, Communication Regarding Grouping of Inventions, copy of Declaration, is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner of Patents, Washington, D.C. 20231.   Pamela Gavette
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COMMUNICATION REGARDING GROUPING OF INVENTIONS

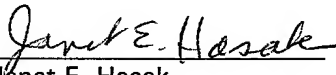
Assistant Commissioner of Patents  
 Washington, D.C. 20231

Sir:

Applicants respectfully request that the Restriction Requirement made in the parent application U.S. Ser. No. 09/477,924 (Paper No. 9 mailed June 14, 2001), which placed peptide, composition, and kit claims in one group (claims 1-6 and 14-20--class 530, subclass 300) and method of treatment claims in a second group (claims 7-13--class 514, subclass 2), be recast to include the kit claims 14-20 together with the method claims 7-13. Because claims 7-20, whether kit or method, relate to pharmaceutical treatment (drug, bio-affecting, and body-treating compositions), they should be considered as a single invention in class 514, subclass 2, and examined together in one application. It is noted that in the enclosed application, original claims 7-20 are now presented as claims 1-14.

Respectfully submitted,  
 GENENTECH, INC.

Date: December 18, 2001

By:   
 Janet E. Hasak  
 Reg. No. 28,616  
 Telephone No. (650) 225-1896




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PATENT TRADEMARK OFFICE

1009477924-12301

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Yves Dubaquitte et al. Serial No.: Unassigned Filed: <u>19</u> December 2001 For: PROTEIN VARIANTS	Group Art Unit: Unassigned Examiner: Unassigned  <b>CERTIFICATION UNDER 37 CFR 1.10</b> <u>EV 016056206 US: Express Mail Number</u> <u>December/9, 2001: Date of Deposit</u>  I hereby certify that this correspondence, consisting of Non-Provisional Application Transmittal Under 37 CFR 1.53(b), specification, formal drawings, Letter and Request to Use Computer-Readable Sequence Listing Under 37 CFR §1.821(e), postcard, Communication Regarding Grouping of Inventions,, copy of Declaration, is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner of Patents, Washington, D.C. 20231.   Pamela Gavette
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Letter and REQUEST TO USE COMPUTER-READABLE SEQUENCE LISTING  
 UNDER 37 CFR §1.821(e)

Box Sequence  
 Assistant Commissioner of Patents  
 Washington, D.C. 20231

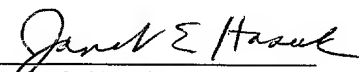
Sir:

Applicants respectfully request that the compliant computer-readable Sequence Listing filed in application Serial No. 09/477,924 be used as the computer-readable Sequence Listing for the present, above-identified application.

The paper copy of the Sequence Listing filed in the present application is identical to the computer-readable copy of the Sequence Listing filed in the application Serial No. 09/477,924.

Respectfully submitted,  
 GENENTECH, INC.

Date: December 18, 2001

By:   
 Janet E. Hasak  
 Reg. No. 28,616  
 Telephone No. (650) 225-1896



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